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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/720,927	10/04/1996	ASHER GIL	G-163 C2	2200

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/720,927	GIL ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8,10,13,14,16 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,10,13,14,16,19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's response of 6/26/06 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,2,4-6,8,10,13,14,16,19, are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ramsden (5481464). Ramsden discloses the claimed invention.

3. Claims 1,5,6,8,10,13,14,16,19-26, are rejected under 35 U.S.C. 102(e) as being anticipated by Wu (5313404).

For claims 1,5,8,10,13,14,16,19-26, Wu discloses an automatic postal machine that accepts items for storage and for pick up by a commercial carrier. The machine has an outer housing, which is the outer walls of the machine itself. The means for weighing an item is the weighing scale 500. The means for inputting information relating to the destination of the item from the customer is the keyboard of buttons 70 on the front of the machine. One of the buttons is 79, which is a domestic mail button. When this button is pressed, this is a step of inputting information that indicates that the mail is domestic, which is information relating to the destination of the item. Domestic

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mail is bound for inside the US, which is a destination for the item. The same holds true for the "air mail" button, which is traditionally associated with overseas mail, which is a destination. Additionally, it is disclosed in column 1, lines 62-end, that the machine can automatically print out the ZIP codes on the mail items according to "the input ZIP codes". Wu discloses a means for inputting information relating to the destination of the item. The control means for calculating shipping charges is the microprocessor that is disclosed in column 4, lines 41-44 as calculating shipping charges. The control means is in communication with the weighing means and the inputting means. The shipping fee that is calculated is based on the weight of the item and the class of service, which can be domestic mail (info. relating to a destination). The means for accepting identification information is the money card reader 711 that is disclosed in column 4, lines 4-9. Applicant has claimed that the means for accepting identification information relating to eventual payment from the customer comprises a means for receiving and reading a credit card. The examiner notes that the structure defined by this language is the same as found in Wu's money card reader 711. The structure is the same. The means for communicating the charges to a central location for billing the charges is satisfied by the disclosure in column 3, lines 65 to column 4, line 3, where it is disclosed that a modem 151 may be added to the system so that data communication with a remote host 150 can occur. This disclosure satisfies the claimed means plus function language. This inherently was done via telephone lines. The examiner wants to note that the act of communicating the charges information to a central location for the billing is not part of the claim, only the structure that is used to accomplish this step.

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The intended use of the communication means does not define over the prior art because the prior art is fully capable of doing what is claimed due to the fact that there is a modem present that can communicate with the remote host 150. The storage area is defined by a 1st zone 162 and a secure zone 161 that the item is moved into for storage. Wu discloses the invention as claimed.

For claims 5,10,16,19,21,22,25,26, in addition to that disclosed above, the means for storing the information associated with the item is satisfied by the disclosure in column 5, lines 3-7, where it is disclosed that payment data of the mail is stored in the microprocessor. This inherently requires a storage device of some kind (memory) which satisfies what is claimed.

For claims 6,16,26, the means for printing a hard copy of a manifest (or the means for printing a hard copy of the shipment fee in claim 16) is the printer, that is disclosed in column 5, lines 3-7 as being capable of printing out the payment data that is stored by the microprocessor. The means for printing is a printer, which is disclosed in Wu.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (5313404) in view of Takesako (4641239).

For claim 2, Wu does not disclose a means for supplying voice instructions for operation of the system as claimed. Takesako discloses an automated banking machine that has a voice instruction unit 17, that supplies instructions to the user of the automated machine on how to operate the machine. The instruction unit includes a speaker to emit the audible instructions. This is present so that users who are not familiar with the operation of the machine can get some guidance on how it works. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Wu with a voice instruction unit as disclosed by Takesako, so that instructions on how to use the postal machine can be given out to users who may not know how to operate the machine. One of ordinary skill in the art would have been motivated to do this because of the fact that many users may not know how to operate the machine and would need some instructions on its operation.

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7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (5313404) in view of Stringer (5042015).

For claim 4, not disclosed is a means for measuring the item size and inputting the size into the control means for use is calculating a shipping charge. Stringer discloses a system that is intended to measure the dimensions and volume of a package that is to be shipped. It is disclosed in column 1 that many shippers calculate shipping charges based on both package weight and package dimensions. This is well known in the art as "dimensional weight". Stringer discloses a system that allows the dimensions of a package to be determined for use in calculating a shipping charge. Because it is known that many shipping companies calculate shipping charges based on both package weight and package dimensions, one of ordinary skill in the art would have been motivated to provide the system of Wu with the ability to measure the item size and input that size into the control means so that the control means can calculate shipping charges by weight and volume (i.e. well known dimensional weight).

8. Applicant's arguments filed 6/26/06 have been fully considered but they are not persuasive.

With respect to the issue of whether or not some of the claims are entitled to a filing date of 4/1/1991, upon consideration of applicant's arguments, the examiner is going to maintain his position that claims 1,2,4-6,8,10,13,14,16,19 are only entitled to a filing date of 8/2/1994. The reason for this is that the scope of some means plus

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function language is not supported in 07/678,863, which means that applicant does not have support for the scope of what is claimed back to 1991. With respect to the limitation of "means for inputting information relating to the destination of the item from the customer", the specification from 07/678,863 disclosed a touch screen or a conventional computer keyboard as being the input mechanism. The instant specification is setting forth guidance to the examiner that the means plus function language is to be given a different scope than that originally disclosed in the 07 case, because now the means language covers the structure of the voice recognition system that is not explicitly disclosed in 07/678,863. The scope of the means for inputting limitation has been set forth in the instant specification to be different than the disclosed touch screen and keyboard from 07/678,863 because it covers different structure and the analysis of what would be an equivalent is also different now because of the newly added embodiment to the voice recognition system. The examiner has read applicant's arguments and notes that applicant has stated and argued that "The written description requirement is satisfied if one of ordinary skill in the art would have understood the inventor(s) to be in possession of the claimed subject matter at the time of filing, even if very nuance of the claims is not explicitly described in the specification. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). The examiner notes that applicant has not used this rationale in arguing that the 07 case supports the claimed scope of the means plus function language and applicant has not taken a position that one of ordinary skill in the art would have understood that 07 series case supports the embodiment of the voice recognition system. The examiner is simply

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concerned that the means plus function language is the presently pending claims has a different scope and covers different structure from what was disclosed in 07/678863.

The scope of the means plus function language is not supported in 07/678,863. Also, the examiner in the last office action had stated that the limitation in claim 10 of a means for transmitting a manifest to a remote location also did not have support back to 1991. The examiner does not see any specific arguments concerning claim 10, but does note that Exhibit A addresses claim 10 and what is claimed. In the exhibit, applicant set forth 6 areas where support can be found in 07/678863, but in the opinion of the examiner, none of them support what is claimed because it does not appear that there was ever a disclosure to having a means for transmitting a manifest to a remote location. At best the manifest is printed locally, but the relied upon sections of 07/678863 do not provide support for what is claimed. This limitation is believed to only go back to 8/2/1994. For these reasons the examiner is maintaining the position that claims 1,2,4-6,8,10,13,14,16,19 are only entitled to a filing date of 8/2/1994. The arguments found under sections C, E, F, and G are found to be persuasive.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

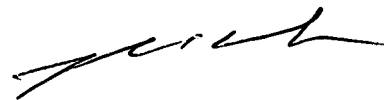
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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